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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/640,369	08/17/2000	Victoria J. Freeman	0065292	5206

7590 10/28/2004

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EXAMINER	
ASHBURN, STEVEN L	
ART UNIT	**PAPER NUMBER**
3714	

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/640,369	FREEMAN, VICTORIA J.	
	Examiner	Art Unit	
	Steven Ashburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 August 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *26-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *26-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

In view of the appeal brief filed on August 2, 2004, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection set forth below. To avoid abandonment of the application, appellant must exercise one of the following two options: (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or, (2) request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins et al., U.S. Patent 4,756,533 (Jul. 12, 1988) in view of Pritchard, U.S Patent 1,217,632 (Feb. 27, 1917).

Hopkins discloses a lottery game designed for promotional and advertising uses. *See col. 1:55-2:8.* The invention combines both luck and skill to present a particularly challenging lottery game. *See id.* The invention employs multiple jig saw puzzles which each contestant must play simultaneously. *See id.* To increase the challenge of the game, all the jig saw puzzles use identical jig saw patterns, all the boards having identical shaped puzzle pieces in identical positions. *See id.* The puzzle pieces are distributed from a common pool, without indication of which puzzle each piece may solve. *See id.* Each contestant thus is challenged to collect all the required puzzle pieces and, using only the visual clues on the face of each piece, to separate the pieces and then solve the various jig saw puzzles. *See id.* The

invention encourages on-going contestant participation, making it very useful for promotional activities. Additionally, the invention is readily combined with "instant win" games and sweepstake lotteries to maximize contestant participation. *See id.* The particular features of the claims described by Hopkins are discussed below.

Claim 26. Hopkins describes the following claim features:

a. Dividing a work into comprised of a correctly ordered sequence into a plurality of distinct parts, each part having no readily identifiable means for determining the correct sequence of the work. *See col. 1:60-66, 2:65-41.* The work is a picture divided into distinct pieces which must be assembled into the a sequence recreating the picture to win an award.

b. Creating a plurality of playing pieces, each playing piece comprising one of the distinct parts. *See fig. 2, 3; 2:30-35.* For example, figure 2(16) illustrates a playing piece created for use in the game.

c. Creating an advertisement. *See col. 1:7-8, 2:3-8, 2:28-29, 3:36-39.*

d. Distributing the playing pieces comprising one of the distinct parts to the public in association with an advertisement. *See col. 1:8-10, 2:21-23.*

e. Collecting playing pieces comprised of the distinct parts. *See col. 1:67-2:2.*

f. Sequencing the playing pieces in to a correctly ordered sequence. *See col. 2:35-41.*

g. Sending an identifier representing the correctly ordered sequence. *See col. 2:21-29, 3:40-45.*

h. Winning a prize for the correctly ordered set of playing pieces representing the work. *See col. 3:45-48.*

As listed above, Hopkins teaches all the features of the claim except the puzzle pieces being parts of a literary work. The specification defines "literary work" as having at least 100 words. This feature would have been obvious to an artisan in view of Pritchard.

Pritchard discloses an analogous puzzle game. *See p. 1:105-2:2. See p. 1:8-25, 1:105-2:2.* Similar to Hitchcock, the games are comprised of works divided into of a ordered sequence comprised of distinct parts wherein each part having no readily identifiable means for determining the correct sequence of the work. *See fig. 4; p. 1:8-25.* However, in Pritchard, the pieces are parts of a literary work. *See fig. 4, 5; p. 1:35-53, 1:97-104.* The literary works may be nursery rhymes, pictures or combinations thereof. Nursery rhymes are commonly over 100 words long. For example, the well known nursery rhyme 'Old Mother Hubbard" is 150 words long. Notably, Pritchard teaches that the use of puzzle pieces contianing pieces of literary works are advantageous because the they instructive for children and adults. *See p. 1:105-109.*

In view of Pritchard, it would have been obvious to an artisan at the time of the invention to modify the puzzle game disclosed by Hopkins, wherein players collect and assemble a puzzle pieces which are distinct parts of a work, to have the include portions of literary works. As suggested by Pritchard, the modification would enhance the puzzle by making the game entertaining, instructive and of variable difficulty for both children and adults. *See p. 1:105-109.*

Claim 27, Pritchard additionally suggests that the advertisement may include a corporate name. *See p. 1:109-2:2.*

Claim 28, Hopkins additionally teaches that the advertisement may be an ongoing advertising campaign. *See col. 1:34-41, 2:30-35, 3:10-16*

Response to Arguments

Applicant's arguments, see Appeal Brief, pp. 4-6 filed August 2, 2004, with respect to the rejection of claim 26 have been fully considered and are persuasive. In particular, the applicant argues that the rejection failed to consider the claim limitation of "literary work" as redefined in the applicant's specification. Therefore, the rejection has been withdrawn and prosecution reopened. However, a new ground of rejection is made demonstrating this feature. Answers to select argument are provided below.

The applicant argues that the references fail to disclose a "literary work" as redefined in the applicant's specification. The examiner disagrees. As detailed above in the new holding, Pritchard discloses distinct pieces from a literary work. *See fig. 4, 5; p. 1:35-53, 1:94-104.* The literary works may be nursery rhymes. Nursery rhymes are commonly over 100 words long. For example, the well known nursery rhyme 'Old Mother Hubbard" is 150 words long. Thus, Pritchard meets the claim limitation of "literary work" as defined in the applicant's specification.

The applicant also argues that the references fail to disclose the features of "associated with an advertisement", "playing pieces", "prize" and "distinct parts" as defined in the applicant's specification. The examiner disagrees. First, the description given in the specification does not redefine the commonly understood meanings of the terms. Second, the descriptions of these terms in the specification are merely exemplary. For example the applicant's specification states, "Playing pieces ***can*** comprise..." and "A prize ***such as***...". Thus, the descriptions do not clearly assign a special meaning to the terms. Furthermore, as detailed in the new holding, Hopkins and Pritchard describe these features.

In addition, the applicant argues that the claimed invention distinguishes over the prior art because neither Hopkins nor Pritchard discloses the preamble's recitation of "promoting literacy". The examiner disagrees. A preamble is generally not accorded any patentable weight where it merely recites

the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In this case, the claim's preamble states "a method for promoting literacy and reading by conducting a competition related to a literary work in association with an advertisement". The examiner interprets the preamble portion of "promoting literacy" as merely reciting an intended use of the game. The body of the claim is directed toward a game and does not depend on the preamble for completeness. Hence, the preamble's recitation of "promoting literacy" has not been given patentable weight.

The applicant argues further that *Kropa* supports the assertion the term "promoting literacy" in the preamble gives life and meaning to the claim. The examiner disagrees. The present case is distinguished from *Kropa, Kropa* held that the preamble containing words "abrasive article" was essential to the point of the invention. In that case, the words "abrasive article" defined a physical aspect of the invention which is essential to the function of the claim elements. In comparison, the words "promoting literacy" describe an intangible concept having no functional relationship to the claim elements. As discussed above, the words merely describe the invention's intended use. Thus the argument is unpersuasive.

In arguendo, even if the preamble's recitation was given patentable weight, Pritchard teaches promoting literacy. In particular, the reference states that including literary works on puzzle pieces makes the game instructive. *See p. 1:105-109.* Thus the combination of Hopkins in view of Pritchard, when taken as a whole by an artisan at the time of the invention, suggests a method of promoting literacy as claimed.

Prior Art, Not Relied On

The following prior art of record is not relied upon but is considered pertinent to applicant's disclosure: 'Nursery Rhymes from Mother Goose – Zelo.com' includes a plethora of common nursery rhymes which are over 100 words long.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.

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